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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,276	07/14/2005	Kyung-Hwa Park	P/4745-3	2717
2352 7590 04/09/2007 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			EXAMINER NGUYEN, KIEN T	
			ART UNIT	PAPER NUMBER
			3711	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/542,276

Applicant(s)

PARK, KYUNG-HWA

Examiner

Kien T. Nguyen

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-21 and 25-55 is/are pending in the application.
- 4a) Of the above claim(s) 15-21, 25-27 and 54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-53, 55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/4/06, 12/12/06</u> | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Applicant's election of Group 7 (Fig. 25) in the reply filed on 02/26/07 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The Examiner disagrees with the selection of claim 54 that allegedly reads on Fig. 25. Claim 54 directs to a rotational shaft and a wheel part, such features are not present in Fig. 25. Accordingly, claim 54 is considered as non-elected claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 28, 30, 44-53, 55 are rejected under 35 U.S.C. 102(b) as being anticipated by Shiraishi U.S. Patent 5,746,638.

Shiraishi disclosed a toy comprising a plurality of parts of polyhedron shape equipped with joining surfaces that are joined with other joining surfaces of other parts as shown in Fig. 2; each part (1) having magnet portion (4) on the joining surfaces (2,2'); the magnet portion of the part and the magnet portion of the joining surface of the parts are joined with each other by magnetic force thereof, the magnet portion comprising a magnet with both magnetic poles (N,S) are arranged to face directions

Art Unit: 3711

different from each other, the magnet being installed on a recess formed on the part, a separation means (see Fig. 5) for preventing a separation of the magnet from the recess, the separation means is a magnet installation member (38) inserted into the recess (36A), the circumferential portion of which surface is in contact with the recess; a lid portion (36) closes an upper opening of the circumferential portion, the installation has a shape of a cylinder of which bottom side is open; the magnet (34) is a cylindrical permanent magnet; the parts can be joined to form a number of shapes.

Claims 28-30, 44-53, and 55 are rejected under 35 U.S.C. 102(a) as being anticipated by Hunts U.S. Patent 6,749,480.

Hunts disclosed a toy as shown in Fig. 1 comprising a plurality of parts of polyhedron shape equipped with joining surfaces that are joined with other joining surfaces of other parts as shown in Fig. 5; each part having magnet portion (3) on the joining surfaces (2); the magnet portion of the part and the magnet portion of the joining surface of the parts are joined with each other by magnetic force thereof, the magnet portion comprising a magnet with both magnetic poles (N,S) are arranged to face directions different from each other, the magnet being installed on a recess (1a) formed on the part, a separation means (see Fig. 2) for preventing a separation of the magnet from the recess, the separation means is a magnet installation member (4) inserted into the recess (36A), the circumferential portion of which surface is in contact with the recess; a lid portion (2) closes an upper opening of the circumferential portion, the installation has a shape of a cylinder of which bottom side is open; the magnet (3) is a cylindrical permanent magnet; the parts can be joined to form a number of shapes.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiraishi in view of WO 03/063993.

It is noted that Shiraishi failed to teach the use of the fixing means as set forth in these claims. However, WO '993 disclosed a magnet installation member (12) having fixing means with a fixing wedge portion extending downward of the circumferential portion so as to be inserted and fixed onto the bottom surface of a magnet installation recess (10) as shown in Fig. 4A. Therefore, it would have been obvious to one of ordinary skill in the art to modify the magnet installation member (38) of Shiraishi with the fixing means as taught by WO '993 for the purpose of rigidifying the connection between the magnet installation member and the recess.

Regarding the alternative forms of the fixing means as set forth in claims 32-43, it would have been a matter of design choice to substitute the fixing wedge portion with any equivalent feature to perform the same function.

Claims 31-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunts in view of WO 03/063993.

It is noted that Hunts failed to teach the use of the fixing means as set forth in these claims. However, WO '993 disclosed a magnet installation member (12) having fixing means with a fixing wedge portion extending downward of the circumferential portion so as to be inserted and fixed onto the bottom surface of a magnet installation recess (10) as shown in Fig. 4A. Therefore, it would have been obvious to one of ordinary skill in the art to modify the magnet installation member (4) of Hunts with the fixing means as taught by WO '993 for the purpose of rigidifying the connection between the magnet installation member and the recess.

Regarding the alternative forms of the fixing means as set forth in claims 32-43, it would have been a matter of design choice to substitute the fixing wedge portion with any equivalent feature to perform the same function.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kien T. Nguyen whose telephone number is (571) 272-4428. The examiner can normally be reached on 7:30 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3711

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Kien T. Nguyen
Primary Examiner
Art Unit 3711

Ktn